

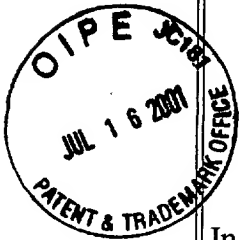
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Customer Number 22,852
Attorney Docket No. 1147.0142



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:)
)
U.S. Patent No. 5,750,338) Group Art Unit: 1655
Mark L. Collins et al.)
) Examiner: D. Johannsen
Reissue Serial No.: 09/533,906)
)
Filed: March 8, 2000)
)
For: TARGET AND BACKGROUND)
CAPTURE METHODS WITH)
AMPLIFICATION FOR)
AFFINITY ASSAYS)

REISSUE LITIGATION BOX

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

SUPPLEMENTAL PRELIMINARY AMENDMENT

Further to the Preliminary Amendment of March 8, 2000, the Patent Owner submits additional claims of intermediate scope to provide protection for several narrower aspects of the invention.

IN THE CLAIMS:

Please add new claims 60-63, as follows:

60. The exponential amplification method of claim 43 wherein the target polynucleotide is amplified with random primers.
61. The exponential amplification method of claim 43 wherein the target polynucleotide is amplified with specially tailored primers.

62. The exponential amplification method of claim 49 wherein the target polynucleotide is amplified with random primers.

63. The exponential amplification method of claim 49 wherein the target polynucleotide is amplified with specially tailored primers.

REMARKS

The Patent Owner has added new claims 60-63 to provide additional protection for several narrower aspects of the claimed invention. Specifically, in light of the Protestor's attempts in the related litigation to construe the claims as encompassing only non-specific, or random, primers in the amplification process, the Patent Owner has now recognized the need for intermediate scope claims directed to both non-specific and specific primers. Thus, the Patent Owner hereby introduces new claims 60-63 to cover those embodiments, as follows.

Claims 60 and 61 specify that the amplification method of claim 43, which depends, ultimately, on independent claim 1 can use either non-specific primers or specific primers. Claims 62 and 63 similarly set forth both non-specific and specific primers for use in the amplification method of claim 49, which ultimately depends from independent claim 7

To best follow the language in the specification, these claims recite use of "random primers" (supported by the various examples including Example 5) or "specially tailored primers" (supported by the discussion at, for example, col. 30, lines 38-40). In the summary of the interview conducted in connection with this application on January 16, 2001, at pages 3-4, it is believed that the Examiners acknowledged support in the specification for use of both specific and non-specific amplification.

Accordingly, these claims are supported by the specification and are in condition for allowance, together with initial claims 1-40 and previously submitted claims 41-59.

If there are any fees due with the filing of this Supplemental Preliminary Amendment not already accounted for, please charge the fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 16, 2001

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FILED